

### **REMARKS**

Claims 1- 37 are pending in the application. Claims 11, 17, 26, 28, 35 and 37 have been amended. New claim 38 has been added. Claims 1-10, 12, 14-16, 18, and 30 have been canceled without prejudice. No new matter has been added.

### **CLAIM OBJECTIONS**

The Examiner has objected to claims 12, 30 and 34 "as being dependent upon a rejected base claim." See Office Action at page 10. Applicant thanks the Examiner for indicating the allowability of these claims. Claim 11 has been amended to include the allowable subject matter of claim 12. Claim 17 has been amended to include the allowable subject matter of claim 12. claim 28 has been amended to include the allowable subject matter of claim 30. New claim 38 contains allowable subject matter of claim 34.

### **CLAIM REJECTIONS**

#### ***Rejection of claims under 35 U.S.C. § 102(b)***

The Examiner has rejected claims 1-3, 7-11, 14-19, 25-29 and 32-33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,782,760 to Schaer ("Schaer"). See Office Action at pages 2-7. Claims 11, 17, and 28 are independent. Claims 1-3, 7-10, 14-16, and 18 have been canceled rendering this rejection moot with respect to those claims.

Schaer discloses "[a]n over-the-wire electrophysiology catheter which has an emitting electrode on the distal tip electrically connected to a source of high frequency electrical energy" (see Abstract). Schaer does not describe a device or a system for ablating tissue that includes a tubular member with a metal tube having an external surface and an electrical insulator configured to electrically insulate a portion of the external surface of the metal tube. Schaer further does not describe a device or a system for ablating tissue that includes an electrode having an exposed portion of the external surface of the outer metal tube or an inner metal tube disposed within the metal tube and defining a portion of the lumen. Schaer also does not describe a blunt distal tip having a fluid sealed junction between the metal tube and the inner tube and the fluid channel being located at least in part between the metal tube and the inner metal tube. See independent claims 11 and 17. Schaer further does not describe a method for

thermal ablation of a target volume where perforating and penetrating includes passing a sharp needle through skin and tissue and positioning includes passing the guide wire through the needle and removing the needle over the guide wire to leave the guide wire in the tract. See independent claim 28.

Accordingly, independent claims 11, 17 and 28 are not anticipated by Schaer. Claims 25, 26, 27, 29, 32-33 that depend from claims 11, 17 and 28 are therefore patentable over Schaer for at least the reasons described above. Applicant respectfully requests reconsideration and withdrawal of this rejection.

***Rejection of claims under 35 U.S.C. § 103(a)***

***Schaer***

The Examiner has rejected claims 4-6, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Schaer. See Office Action at page 7. Claims 4-6 have been canceled thus rendering this rejection moot with respect to those claims. Claim 13 is dependent on claim 11.

As previously discussed, Schaer discloses “[a]n over-the-wire electrophysiology catheter which has an emitting electrode on the distal tip electrically connected to a source of high frequency electrical energy” (see Abstract). Schaer does not teach or suggest a device for ablating tissue that includes a tubular member with a metal tube having an external surface and an electrical insulator configured to electrically insulate a portion of the external surface of the metal tube. Schaer further does not describe a device or a system for ablating tissue that includes an electrode having an exposed portion of the external surface of the outer metal tube or an inner metal tube disposed within the metal tube and defining a portion of the lumen. Schaer also does not describe a blunt distal tip having a fluid sealed junction between the metal tube and the inner tube and the fluid channel being located at least in part between the metal tube and the inner metal tube. See independent claim 11.

Accordingly, since claim 13 is dependent on claim 11 and shares the same features, dependent claim 13 is allowable over Schaer. Applicant respectfully requests reconsideration and withdrawal of this rejection.

***Schaer in view of Panescu***

The Examiner has further rejected claims 20-25, 27, 31 and 35-37 under 35 U.S.C. § 103(a) as being unpatentable over Schaer in view of U.S. Pat No. 5,688,267 to Panescu ("Panescu"). See Office Action at pages 9-10. Claims 20-25 depend from independent claim 17, claim 31 depends from independent claim 28 and claims 35-37 depend from independent claim 11.

As discussed above, Schaer fails to teach or suggest a device or a system for ablating tissue as described in independent claims 11 and 17. Schaer further fails to teach or suggest a method for thermal ablation of a target volume where perforating and penetrating includes passing a sharp needle through skin and tissue and positioning includes passing the guide wire through the needle and removing the needle over the guide wire to leave the guide wire in the tract. See independent claim 28.

Panescu does not remedy this defect in Schaer. The system and method for ablating tissue in Panescu utilizes an "electrode for contacting tissue to form a tissue-electrode interface" (see Abstract). Panescu however, does not teach or suggest a device or a system for ablating tissue that includes a tubular member with a metal tube having an external surface and an electrical insulator configured to electrically insulate a portion of the external surface of the metal tube. Panescu further fails to teach or suggest a device or a system for ablating tissue that includes an electrode having an exposed portion of the external surface of the outer metal tube or an inner metal tube disposed within the metal tube and defining a portion of the lumen. Panescu also fails to teach or suggest a blunt distal tip having a fluid sealed junction between the metal tube and the inner tube and the fluid channel being located at least in part between the metal tube and the inner metal tube. See independent claims 11 and 17.

Panescu also fails to teach or suggest a method for thermal ablation of a target volume where perforating and penetrating includes passing a sharp needle through skin and tissue and positioning includes passing the guide wire through the needle and removing the needle over the guide wire to leave the guide wire in the tract. See independent claim 28.

Accordingly, the above-cited references, alone or in combination, fail to teach, suggest or motivate a person skilled in the art to make device or a system that includes a tubular member with a metal tube having an external surface and an electrical insulator configured to electrically insulate a portion of the external surface of the metal tube as described in independent claims 11,

and 17. None of the above-cited references, alone or in combination, teach or suggest the method for thermal ablation of a target volume as described in independent claim 28. Applicant respectfully submits that dependent claims 20-25, 31 and 35-37 are allowable over Schaer in view of Panescu. Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **CONCLUSION**

For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the pending rejections. Applicant believes that the claims now pending are in condition for allowance.

Should any fees be required by the present Amendment, the Commissioner is hereby authorized to charge Deposit Account **19-4293**.

If, for any reason, a telephonic conference with the Applicant would be helpful in expediting prosecution of the instant application, the Examiner is invited to call Applicant's Attorney at the telephone number provided below.

Respectfully submitted,



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